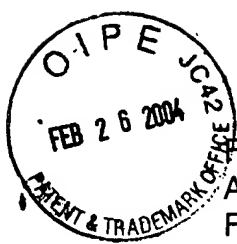


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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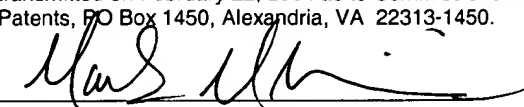
First Named Inventor: Levitan
Application Number: 09/544,799
Filing Date: April 7, 2000
Title: Magnetically Actuated
Microelectromechanical Systems Actuator

MAR 03 2004

OFFICE OF PETITIONS

Date of Amendment: February 22, 2004

Examiner: Shafer, R.
Art Unit: 2872

<p><u>Certificate of Mailing Under 37 C.F.R. § 1.8</u></p> <p>I hereby certify that this paper and the documents referred to in the foregoing attached or enclosed herewith are being transmitted on February 22, 2004 as to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.</p> <p></p> <p>Mark M. Meininger (Registration No. 32,428) Attorney of Record</p>
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RESPONSE TO SECOND REQUIREMENT FOR RESTRICTION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Applicants respond as follows to the requirement for restriction made in the Office action dated April 23, 2003.

Claims 1-38 are in the application. The Examiner restricted the application to one of the following groups of claims:

- I. Claims 1-10
- II. Claims 11-16
- III. Claim 17-23
- IV. Claims 24-30
- V. Claims 31-38

Applicants elect the claims of group II with traverse. Applicants traverse the restriction requirement for the following reasons.

The Examiner states that the claims of Groups I-V are related subcombinations that are disclosed as useable together in a single combination. Applicants submit that the inventions of Groups I-V are not "related

subcombinations that are disclosed as useable together in a single combination,” and request that the restriction requirement be withdrawn.

The Examiner makes no showing that the inventions recited in the claims of Groups I-V are disclosed in the application as being related as subcombinations that are useable together as a combination. Accordingly, the basic distinction upon which the restriction requirement is based is unsupported, and the restriction requirement is therefore improper.

The Examiner states that the claims of Group I are directed to a microelectrical mechanical actuator, that the claims of Group II are directed to a microelectrical mechanical actuator, that the claims of Group III are directed to a mirror actuator device, that the claims of Group IV are directed to a microelectrical mechanical system, and that the claims of Group V are directed to a microelectrical mechanical actuator. However, the Examiner makes no showing of a combination invention that combines an article from any of Groups I-V with another article from any of the other Groups.

In particular, the Examiner makes no showing of an article of Group I forming a combination with an article from any of Groups II-V. The Examiner makes no showing of an article of Group II forming a combination with an article from any of Groups I or III-V. The Examiner makes no showing of an article of Group III forming a combination with an article from any of Groups I, II, IV or V. The Examiner makes no showing of an article of Group IV forming a combination with an article from any of Groups I-III or V. The Examiner makes no showing of an article of Group V forming a combination with an article from any of Groups I-IV. Accordingly, the Examiner has made no showing that the invention in any of Groups I-V is related as subcombinations that are useable together as a combination. The restriction requirement is, therefore, improper and should be withdrawn.

Moreover, the Examiner lists different features recited in the claims of each group and, on that basis alone, concludes that each group has separate

utility from the other groups. With regard to Group II, for example, the Examiner states:

“the microelectrical mechanical actuator of group II has separate utility as a microelectrical mechanical actuator without the mirror of groups III and IV, the movable device or the electromagnet of group V or the planar substrate having a first conductor coupled to source at a first electrical potential, a second conductor coupled to source at a second electrical potential, wherein the second electrical potential is less than the first electrical potential of group I”

As set forth in MPEP 806.05(d), the Examiner is required to “suggest utility other than with the invention.” (Emphasis added.) Applicants submit that mere recitation of different claim features does not adequately demonstrate separate utility.


In particular, the Examiner does not state what separate utility the actuator of group II has relative to the actuators with mirrors in groups III and IV. The Examiner states that the actuator of group II has separate utility from elements of the actuators of groups I and V, but identifies no separate utility between the actuator of group II and the actuators of groups I and V. The statements of separate utility between group II and the other groups are therefore incomplete and improper, and the restriction requirement as to group II should be withdrawn.

The Examiner makes the very same statements of separate utility in connection with group III relative to the other groups, and in connection with group IV relative to the other groups, and in connection with group V relative to the other groups. Applicants submit that these identical explanations of separate utility are incomplete and improper for the reasons set forth above with regard to group II. Moreover, the Examiner provides no separate explanation of the separate utility of group I relative to the other groups. Applicants request, therefore, that the restriction requirement between groups I-V be withdrawn.

For the foregoing reasons, applicants request withdrawal of the
requirement for restriction.

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Respectfully Submitted,


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